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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,839	12/01/2000	Reinhard Storbeck	BEIERSDORF 671-WCG	4244

7590 02/11/2002
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EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 02/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-17 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-17 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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1. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wienberg, the U.S. equivalent of DE 19628317 cited by applicant in the specification on page 2, taken either individually, or in view of the Handbook of Adhesives, Second Edition (1977) Chapter 47. The primary reference discloses (note particularly Figures 1 and 3, column 1 lines 46-61, column 2 lines 3-26, column 3 line 21 - column 4 line 12) a closely related adhesive tape and accompanying method of using it for flying reel changes in paper finishing machines and the like. The reference discloses an adhesive tape suitable for splicing having a paper backing coated with adhesive on one outer surface and on the opposing inner surface discloses (e.g. Figure 3) a double sided adhesive tape that can be positioned at one side of the paper backing arranged along one of the long edges of the adhesive tape. Applicant's claimed tape differs primarily in its selection of a film, as opposed to a paper backing. However,

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the Examiner believes that one of ordinary skill is aware of both the ^{relative} advantages and disadvantages of both paper and film, i.e. polymeric materials, which can be employed as adhesive tape backings. Alternatively, the secondary reference discloses, particularly at page 725 the fact that paper and film backings are often used interchangeably in the art, with the particular selection being primarily predicated around an attempt to improve the internal strength of the backing, that is, ^{e.g.,} if a stronger material is desired, the polymeric film is utilized, while if not the cheaper paper backing is usually the selection of choice. In any event, such selections are well known to one of ordinary skill in the art. Additionally, as regards the selection of the particular location of the double sided adhesive tape (DO) on one surface of the tape backing, it is noted that its position can be at the edge or indented as much as 15 mm from one long edge of the tape. As such, the reference is believed to specifically teach such ^{range of} [^] locations, and it is further believed that Weinberg discloses more embodiments than just the positioning of the double sided adhesive tape at the edge of the first paper backing.

With respect to the remaining dependent claims, these are each believed to be, if not expressly or inherently disclosed, obvious modifications to one of ordinary skill in the absence of unexpected results.

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3. The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 09/518,463 or 09/490,709 in view of the Handbook of Adhesives, Second Edition (1977) Chapter 47. The claims are substantially identical except for applicant's claiming a "film" backing instead of the paper backing shown by each of the applications that are relied upon as primary references. However, the secondary reference is again relied upon as set forth above, showing the well known at least partial equivalence of film versus paper backings in the adhesive tape art.

This is a provisional obviousness-type double patenting rejection.

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5. Applicant has provided evidence in this file showing that the invention was owned by, or subject to an obligation of assignment to, the same entity as either Serial No. 09/490,709 or 09/518,463 at the time this invention was made. Accordingly, these two copending applications are disqualified as prior art through 35 U.S.C. § 102(f) or (g) in any rejection under 35 U.S.C. § 103(a) in this application. However, this applied art additionally qualifies as prior art under subsection (e) of 35 U.S.C. § 102 and accordingly is not disqualified as prior art under 35 U.S.C. § 103(a).

Applicant may overcome the applied art either by a showing under 37 CFR 1.132 that the invention disclosed therein was derived from the invention of this application, and is therefore, not the invention "by another," or by antedating the applied art under 37 CFR 1.131.

6. Claims 1-17 are provisionally rejected under 35 U.S.C. § 103(a) as being obvious over copending Application No. 09/518,463⁶³ or 09/490,709 which has a common co-inventors with the instant application. *each in view of the Handbook of Adhesive reference* Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. § 102(e) if patented. This provisional rejection under 35 U.S.C. § 103(a) is based upon a presumption of future patenting of the conflicting application. More particularly, the Examiner repeats the combination rejections in

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which the secondary reference is again the Handbook of Adhesives as was earlier set forth above.

This provisional rejection might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by a showing of a date of invention for the instant application prior to the effective U.S. filing date of the copending application under 37 CFR 1.131.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note also the U.S. equivalents of several of the cited prior art references. That is Caudal et al., Madrzak et al. and Wienberg et al., as well as EP 418527, A patent Abstract.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

February 5, 2002

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1300-
1700

Daniel Zinker